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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,977	06/10/2004	Lydia Breck	03292.101070.2	3976

66569

7590

05/27/2009

FITZPATRICK CELLA (AMEX)  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 05/27/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

### **DETAILED ACTION**

1. The amendment filed on 1/30/2009 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because the previous invention includes recording a record of the transaction in the non-currency-based-account STN profile.

The reply filed on 1/30/09 is not fully responsive to the prior Office Action because of the following matter (See 37 CFR 1.111). Claims 1-11 were cancelled and the new claims 12-17 are directed toward a different independent or distinct invention, as explained below. Accordingly, claims 12-17 have been withdrawn from consideration as being directed to a separate non-elected invention. See 37 CFR 1.142b and MPEP 821.03. Thereby no claims are left pending for examination. See 37 CFR 1.111. The amendment filed on 1/30/09 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03).

2. New claims 12-17 are directed to an invention that is independent or distinct from the invention originally claimed in 1-11 for the following reasons. Restriction to one of the following inventions would have been required under 35 USC 121 if group 1 had not been cancelled:

- I. Claims 1-11, drawn to a method and a medium with instructions for a method for facilitating a non-currency based transaction with a secondary transaction number (STN), classified in class 705, subclass 39.
- II. Claims 12-17, drawn to a method and medium with instructions for a method and a medium with instructions for a method, classified in class 705, subclass 39.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. Invention I includes recording a record of the transaction in the non-currency based account STN profile, but does not include a smart card or an STN icon. Invention II includes providing a smart card and displaying and selecting an STN icon, but does not include an STN profile or recording a record. Invention I is separately usable for transactions without a smart card.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Conclusion***

3. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN LOFTUS whose telephone number is (571)272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692